



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,039	01/29/2004	Hiroyuki Hatta	1538.1045	2575
21171	7590	01/24/2011		
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER LEE, WILSON	
			ART UNIT 2163	PAPER NUMBER
			MAIL DATE 01/24/2011	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/766,039

Applicant(s)

HATTA ET AL.

Examiner

Wilson Lee

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-16 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 3-15 is/are allowed.
- 6) ☒ Claim(s) 16 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Remarks

The application has been withdrawn from issue after further consideration.

Claim Rejections – 35 U.S.C. 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 16 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter due to a computer readable medium including digital signal. When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic wave, carrier, signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium such as electromagnetic wave, carrier, or signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8.

Claim 16, the cited computer readable medium, may contain digital signal. Transmission mediums such as signals and carrier waves represent physical characteristics of a form of energy that do not fall within any of the categories of patentable subject matter set forth in 35 U.S.C. 101. Because forms of transmission mediums such as signals and carrier waves do not fall within any of the categories of patentable subject matter set forth in 35 U.S.C. 101, thus the claim is rejected.

Art Unit: 2163

In order to overcome the 35 U.S.C. 101 rejection to claim 16, the applicant ***positively disavow***, on the record, the embodiments of the inventions that include a computer readable medium wherein the computer readable medium is a digital signal or the like.

Claim 18 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a test of whether the invention is categorized as a process, machine, manufacture or composition of matter and if the invention produces a useful, concrete and tangible result. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) are found to be non-statutory subject matter.

The elements for apparatus are seemingly software components. It is merely functional descriptive material and is nonstatutory. Thus, it fails to include any physical hardware to constitute an apparatus as claimed. The claimed elements could be reasonably interpreted in light of the disclosure by an ordinary artisan as being software alone, and thus is directed to software per se, which is non-statutory.

Line 2, "storage" may contain digital signals therefore it is not statutory.
See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8.

In order for such an apparatus claim to be statutory, it must be claimed in combination with an appropriate medium (e.g. non-transitory, etc.) and/or hardware (e.g. processor, server, computer, etc) to establish a statutory category of invention and enable any functionality to realized.

Allowable subject matter

Claims 1, 3-15 are allowed.

The following is an examiner's statement of reasons for allowance:

The prior art neither discloses nor suggests the following limitations, in combination with the remaining elements as disclosed in claim 1:

first and second transforming said extracted data of said plurality of documents into first display information that indicates said extracted data of said plurality of documents to said user in a first and a second display forms that include one or more generated displayed items;

each said first and second display forms is one or more of

“a first form showing indications of the extracted documents that have been classified by used words in said extracted documents,

a second form showing indications of said extracted documents, and segments between the indications, each said segment representing a degree of relevancy between said extracted documents, that is calculated by used words in said extracted documents,

a third form showing a graph representing a result obtained by classifying and aggregating said extracted documents based on used words in said extracted documents;

a fourth form showing used words in said extracted documents and segments representing a degree of relevancy among said used words,

a fifth form showing first indications of document groups, second indications of used words in said extracted documents, and segments between

Art Unit: 2163

said first indications and said second indications, said document group being composed of said extracted documents associated by a specific matter, and each of said segments representing a degree of relevancy between said document group and said used word.”

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled “Comments on Statement of Reasons for Allowance.”

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lennon et al. (US 2003/0018607) teaches that the source metadata is transformed into an element tree which is a form of normalizing the metadata [0103], user can choose the item and link to be presented or played [0194], accessing different patent databases [0222] but Lennon fails to teach first, second and third search condition in a follow up search process and first, second transformation of extracted data into information to indicate the extracted data of the plurality of documents to user in first display form and second user designated display form.

Warnock et al. (7,536,561) teaches that IBM Intellectual Property network allows to search free in a number of patent databases and to view a textual representation (Col. 1, line 64 to Col. 2, line 38) but Warnock fails to teach first, second and third search condition in a follow up search process and first, second

Art Unit: 2163

transformation of extracted data into information to indicate the extracted data of the plurality of documents to user in first display form and second user designated display form.

Hill (7,433,881) teaches in figure 7 that storing images from a presentation in an image database which are converted into multiple formats or resolutions, the image format is presented to the user via the display device. And if the user accepts the format, then the image in the selected format is copied into the user's presentation. Hill also teaches that user can select a presentation format (figure 4). However, Hill fails to teach first, second and third search condition in a follow up search process and first, second transformation of extracted data into information to indicate the extracted data of the plurality of documents to user.

Bayiates (7,082,436) teaches a GUI for displaying a sample visual form of data, a region enabling a user to input location data identifying a location of data selected by the user. (Col. 2, line 52 to Col. 3, line 11). However, Bayiates fails to teach first, second and third search condition in a follow up search process and first, second transformation of extracted data into information to indicate the extracted data of the plurality of documents to user.

Kato et al. (6,094,647) teaches a list on the display or to read text data of hit documents from the collective type magnetic disk unit based on the designation of a user to indicate the text data on the display (Col. 30, lines 48-61). However, Kato fails to teach first, second transformation of extracted data into information to indicate the extracted data of the plurality of documents to user in first display form and second user designated display form.

Art Unit: 2163

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Wilson Lee whose telephone number is (571) 272-1824.

Papers related to the application may be submitted by facsimile transmission. Any transmission not to be considered an official response must be clearly marked "DRAFT". The official fax number is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

1/20/2011

/Wilson Lee/
Primary Examiner, Art Unit 2163